

Appl. No. 09/811,028
Amdt. Dated April 8, 2005
Reply to Office Action of January 25, 2005

Attorney Docket No. 1991-174 (81841.0154)
Customer No.: 26021

REMARKS/ARGUMENTS:

Claims 1-24 are pending in the application. Reexamination and reconsideration of the application, in view of the following remarks, are respectfully requested.

CLAIM REJECTIONS UNDER 35 U.S.C. § 103:

Claims 1-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tersteeg et al. (U.S. Patent No. 4,219,529) in view of Minekane (U.S. Patent No. 4,906,433) and Kerr et al. (U.S. Patent No. 5,075,079). The Applicant respectfully traverses this rejection.

Claim 1 is as follows:

A rotary incubation station of an automated analyzer, comprising:

- a. a platform;
- b. a generally circular ring-shaped outside rotary wheel having a plurality of nesting locations for washing and reading vessels;
- c. means for positioning said outside rotary wheel on said platform, allowing said outside rotary wheel to rotate;
- d. a generally circular disc-shaped inside rotary wheel having a plurality of nesting locations for incubation and storage of vessels;
- e. means for positioning said inside rotary wheel on said platform inside said outside rotary wheel, allowing said inside rotary wheel to rotate;
- f. first spur gear means for rotating said outside rotary wheel including a plurality of spur gear teeth on the inner periphery of

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the outside rotary wheel, wherein the first spur gear means allows accurate control of the rotation of said outside rotary wheel;

g. second spur gear means for rotating said inside rotary wheel independent of the rotation of said outside rotary wheel, the second spur gear means comprising a plurality of spur gear teeth on the outer periphery of the inside rotary wheel and allowing accurate control of the rotation of said inside rotary wheel; and

h. two pick and place assemblies for transferring vessels between the inside rotary wheel and outside rotary wheel.

Applicant respectfully submits that the cited references cannot render claim 1 obvious because the cited references fail to teach or suggest a rotary incubation station of an automated analyzer, comprising two pick and place assemblies for transferring vessels between the inside rotary wheel and outside rotary wheel.

The Examiner states,

"It would have been obvious to one of ordinary skill in the art to use a two wheel system such as disclosed in Minekane in the analyzer of Tersteeg to decrease the time needed for the reagent vessels to move throughout the system and be filled with reagent. Tersteeg et al further differ from the instantly claimed invention in that there is no disclosure of two pick and place assemblies. Kerr et al teaches a slide analysis system comprising a slide holding module and a incubator module. The system further includes a pick and place mechanism (18) for withdrawing slides from the slide holding mechanism and inserting them into the incubator module. See abstract. It would have been obvious to one of ordinary skill in the art to modify the Tersteeg et al reference by including at least two pick and place assemblies to

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provide a means for moving test slides throughout the incubator system. Multiple pick and place mechanisms would increase the throughput of the system."

The Applicant respectfully disagrees. Tersteeg states,

"It is the object of the invention to provide an improved incubator, for use with a chemical analyzer of the type which employs test slides, in which slides can be readily transferred between the incubator and elements of the analyzer by means of a slide conveyor which cooperates with a plurality of transfer mechanisms." (Tersteeg, column 2, 33-39).

Thus, according to Tersteeg, the object of the invention comprises transferring slides between the incubator and elements of the analyzer using a slide conveyor. Thus, according to Tersteeg, there already exists a method for transferring slides between the incubator and elements of the analyzer; and that method involves the use of a slide conveyor and not a pick and place mechanism. Consequently, modifying Tersteeg to include two pick and place mechanisms to provide a means for moving test slides throughout the incubator system, as suggested by the Examiner, would change the principle of operation of Tersteeg.

The MPEP states,

"If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." MPEP 2143.01

Since modifying the invention of Tersteeg would change the slide conveyor system, the teachings of Tersteeg are not sufficient to render the invention *prima facie* obvious. Furthermore, as was previously indicated in the Applicant's response

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to the Office Action dated October 7, 2003, nothing in Tersteeg teaches or suggests a two-wheel incubation station, much less a two-wheel incubation station with the claimed position of gear teeth and independently rotating wheels.

In Minekane, the inner and outer wheel system allows movement of the reagent holders throughout the system in a circular manner, which greatly shortens the time needed for the reagent holder to move to the position where the reagent is drawn. Thus, in Minekane, there is no need for a pick and place mechanism. Furthermore, in Minekane reagent holders are not transferred between the inside and outside rotary wheels.

Kerr fails to teach or suggest an inside and outside rotary wheel and is not relied upon by the Examiner for such. Instead, as discussed above, the Examiner relies on Kerr for teaching a slide analysis system comprising a slide holding module and a incubator module, wherein the system further includes a pick and place mechanism. However, also as discussed above, modifying the system of Tersteeg by introducing the pick and place mechanism of Kerr would change the principle of operation of Tersteeg.

In light of the foregoing, Applicant respectfully submits that the references discussed above could not have rendered claim 1 obvious, because the combination of references fails to teach or suggest each and every claim limitation. Claims 2-10 depend from claim 1 and are patentable over the cited references for at least the same reasons as claim 1. Withdrawal of these rejections is thus respectfully requested.

Claims 11-24 although not depending from claim 1, require the similar limitation of two pick and place assemblies for transferring vessels between the inside rotary wheel and outside rotary wheel. Therefore, claims 11-24 cannot be

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rendered obvious over the cited references for the same reasons discussed above. Withdrawal of these rejections is thus respectfully requested.

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. Reexamination and reconsideration of the application, in view of the foregoing remarks, are requested.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California telephone number (213) 337-6700 to discuss the steps necessary for placing the application in condition for allowance.

If there are any fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-1314.

Respectfully submitted,
HOGAN & HARTSON L.L.P.

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By: Barry M. Shuman
Wei-ning Yang (Contact Person)
Registration No. 38,690
Attorney for Applicant(s)
Barry M. Shuman
Registration No. 50,220

500 South Grand Avenue, Suite 1900
Los Angeles, California 90071
Phone: 213-337-6700
Fax: 213-337-6701